

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Forrest RHOADS et al.

Application No.: 10/751,269

Filed: December 30, 2003

For: **KNOWLEDGE-MANAGEMENT  
SYSTEMS FOR LAW FIRMS**

Art Unit: 2165

Examiner: Syed, Farhan M.

Confirmation No.: 9691

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**SUPPLEMENTAL DECLARATION OF DONALD HAYDEN**  
**UNDER 37 C.F.R. § 1.132**

I, Donald Hayden, declare as follows:

1. I am a Product Manager for Thomson Reuters. Thomson Reuters is a business entity related to Thomson Reuters Global Resources GmbH, the Assignee of the above-identified patent application.

2. Among other things, I have been significantly involved with the development and implementation of a product called West km. West km is a software product that is designed for use principally by law firms or legal departments of companies, for example. More particularly, it is designed to help a law firm or legal department leverage its accumulated knowledge that is stored in the form of electronic memoranda and briefs. Put another way, this product is designed to help law firms and similar organizations with "knowledge management." An example of a user manual for this software product is annexed to the specification of the above-referenced patent application.

3. I have read and am familiar with the above-identified patent application, the *final* Office Action dated December 15, 2010 and the references cited therein, and particularly, U.S. Patent No. 5,991,751 ("Rivette") alone, or in combination with U.S. Patent No. 6,556,992 ("Barney") or in further combination with U.S. Patent Application Publication No. 2002/0147745 ("Houben"). I am and have been very familiar with the state of the art of knowledge management systems for many years.

4. I am submitting this Declaration under 37 C.F.R. §1.132 to overcome the Examiner's rejection of Claims 2-14, 22-26, 27 and 29 of the subject application under 35 U.S.C. §103 as unpatentable over Rivette, Barney and Houben either alone or in view of other references cited by the Examiner. This Declaration supplements my previously filed Declaration dated September 17, 2010, which is referred to herein as My First Declaration.

***WEST KM SOLVES A LONG-FELT, UNRESOLVED NEED***

5. Annexed to My First Declaration are a series of case studies that summarize the experience of individual clients with the West km product. These case studies are helpful for the Patent Office to understand how the West km product solves a long-felt, but unresolved need, in the art. Similarly, these case studies show the significant commercial success that the West km product enjoys and how the commercial success results from its technical features, particularly its emphasis toward legal subject matter. To avoid duplicity, the case studies are not annexed to this Declaration.

6. Prior to the development of West km, law firms generally relied on document management systems, such as the PC DOCS or IManage systems, to control their documents and make work product available firm-wide. A goal of these systems

was to help law firms with knowledge management. For example, these kinds of systems in theory would permit anyone at a law firm to go into the system and look, for example, for a memorandum on a topic of law. However, these document management systems have done little more than make it easier for a user to find documents that they have worked on in the past. Their ability to permit a user to cross-leverage the work product of other people is severely limited. In the words of one Thomson-Reuters customer, Downey Brand LLP:

In the past, the searching capability of the document management system was so limited that people used it primarily to access their own working documents. We had 800,000 documents indexed in our document management system but the attorneys couldn't find the knowledge they needed within that collection.<sup>1</sup>

In my experience, this is typical for institutions that have not adopted the West km product. Mr. Libby, of Downey Brand LLP, tried to solve this problem, and did not succeed:

West km was appealing to Libby on many levels. He originally approached knowledge management 15 years ago, creating key term index databases for opinions and documents drafted by attorneys in an effort to make the information accessible to others. *"It was really an index to documents. I was reading documents and trying to pull key issues or subject matter so that someone could do a search that would find those documents based on legal issues. It took a tremendous amount of effort on my part to keep the system going, and it was very limited, and ultimately, very flawed."*<sup>2</sup>

As the activity that Mr. Libby refers to as 15 years ago was approximately in the year 1998, one can see that the problems in the state of the art persisted for years until the subject technology solved the persistent need. In the year 2005, once Downey Brand implemented the West km platform that allows a single query to retrieve by careful

<sup>1</sup> Exh. 1 of My First Declaration at 1; Downey Brand Case Study.

<sup>2</sup> Exh. 1 of My First Declaration at 2 (emphasis added).

selection of internal and external documents using the document vetting feature of West km, response at Downey Brand was overwhelming:

When West km was rolled out at Downey Brand, attorneys were offered a 30-minute training session to learn how to use it. Attendance at trainings and interest among the firm's attorneys were unprecedented. "We had 98 or 99% participation," says Mike Libby. "That was just unheard of. They were on fire." Libby explains the ready acceptance of West km this way: "One of the key things that allowed our implementation to be so successful is that anyone in the firm can use this tool and they see it as helping them to do their jobs better."

7. In one aspect, West km is desirable because it tailored for the legal field.

As stated by another Thomson Reuters customer:

West km offers three things over anything else out there. It's targeted for attorneys; provides a simple tool for research on your own internal documents; and it's very easy to use.<sup>3</sup>

8. Baker Donelson also had a well-viewed rollout of West km. In the years from 1990 to 2003, prior to West km introduction in the year 2004, Baker Donelson was suffering from an inability to leverage its internal documents:

"The [document management system] platform we have certainly meets the goals of its primary purpose," Williams said, "but it was lacking in the ability to provide effective and efficient search results. In the practice of law, time is money, and we are always cognizant of that fact. The more effective we can make the searching, the more money we are able to save for our clients."<sup>4</sup>

As with other customers, Baker Donelson chose West km in the year 2004:

Ultimately, we chose West km because it puts to use our firm's best work, regardless of the practice area, allowing us to increase our knowledge sharing and knowledge transfer...

"West km is the base of our knowledge management system," Williams explained. "It takes our volumes of documents -- our intellectual capital --

<sup>3</sup> Exh. 2 of My First Declaration; Rider Bennett case study.

<sup>4</sup> Exh. 3 of My First Declaration; Baker Donelson case study.

and unlocks the value of our work product and knowledge. It sits within our intranet and is highly integrated with our systems.”<sup>5</sup>

In fact, prospective clients of Baker Donelson have even shown demand for the West km product because they appreciate it can result in more efficient service:

“More and more, knowledge management is a requirement of new clients,” Williams said. “It’s a differentiating factor. Many client RFPs now contain specific questions or sections about the firm’s KM capabilities and tools. They want to know how we are going to better use their money and our time. With West km and the way we have implemented it, we offer our clients much more in the way of knowledge management than other firms.”

Baker Donelson, as with many other West km customers, have enjoyed seen the long felt need for effective, efficient searching of internal and external documents resolved because of the West km platform.

9. It seems that the benefits of the West km product scale with the size of the organization. ReedSmith LLP, a 3200+ attorney firm,

“The volume of data created and stored on our network is increasing at an extraordinary rate, making the KM task more difficult than ever before,” he explained. “Law firms like ours that deal with complex litigation, cross-border disputes and crucial regulatory matters simply cannot overlook KM. Our people needed a better way to quickly access the information and needed to be as productive and efficient as possible to use that information to provide our clients with the best possible level of service.”<sup>6</sup>

ReedSmith has used West km to leverage its internal content in combination with another portal developed for the firm. Even so, the claimed features of West km have proven to be the enabling factor for successful searching:

“The integration of West km contextual enhancements into the already powerful search functions, as illustrated by the list of citations in the faceted areas (on the left of the screen) allows our attorneys to fine-tune

<sup>5</sup> Exh. 3 of My First Declaration at 1.

<sup>6</sup> Exh. 4 of My First Declaration; ReedSmith case study at 2.

their searches by specific criteria," Tom explained. "West km's unsurpassed expertise in citations makes this an invaluable element of the search."<sup>7</sup>

ReedSmith's experience shows that West km's design of selecting, filtering and converting documents in to a markup language is valuable, particularly because West km allows searching internal and external documents with a single query and is geared to the legal field because West km is integrated with legal citation filters. ReedSmith's experience is that its employees have been adopting the West km tool:

"We've been tracking utilization of this tool, and we are getting thousands of searches a day," Tom said, obviously pleased with the results. And when you look at the searches people run, oftentimes the first results they see are documents from West km. So, we are seeing a considerable uptick in terms of usage of metadata and content West km is generating on our work product. We are getting a much higher level of access and use than we ever had before."

In my view, the users of West km at ReedSmith and elsewhere have adopted the system in their daily practice because of the claimed technical features that make searching internal law firm content and external content with a single query more useful.

10. In my experience, some attorneys even want West km after they have been familiarized with it but haven't even used it. In association with the rollout at Keesal, Young and Logan (Keesal) in the year 2004:

"When we first presented the concept of West km to the attorneys in our firm their faces lit up," said Justin Hectus, Director of Information at Keesal, Young and Logan. "They immediately realized it would be of significant value to their practice. West km will enhance our ability to leverage existing firm work product, and the increased efficiencies will directly benefit our clients."<sup>8</sup>

Keesal adopted West km and has benefited from it, as with so many other West km customers.

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<sup>7</sup> Exh. 4 of My First Declaration at 5.

<sup>8</sup> Exh. 5 of My First Declaration; Keesal summary at 1-2.

11. Within the first year of its release in the year 2003, West km was adopted by more than 75 of the world's leading legal organizations, including law firms, corporate legal departments and government agencies. (Exh. 5 at 2). This widespread and rapid adoption is proof of the commercial success provided to Thomson Reuters by the West km product.

12. The features of the West km product simply permit attorneys to save time and leverage knowledge, which is simply invaluable when time is limited. In the words of a partner at Greenberg Traurig LLP:

"There was an issue that I needed to research very specifically and I found what appeared to be a leading case on the issue. I was pleased to see the Greenberg Traurig logo pop up next to it. It was a memo that had been done elsewhere in the firm. It had the blessing of the updating that is included within the documents and I probably shaved a good two hours off of my research time – which would be a boon if I were sitting in my office. It was doubly so because I was working over vacation and able to finish a good chunk of the work in far less time."<sup>9</sup>

As is shown again above, the basis for customer demand of the West km product is what it can do for attorneys.

13. In view of the above, it is apparent that West km addressed a persistent problem in the prior art. From at least the time of recognition by Mr. Libby in 1998 to the recognition of Jamie Blomquist in 1990 to the recognition by Meredith Williams in 2000 to Tom Baldwin, who was still looking for a solution in 2008, the long-felt need for solutions as claimed by the subject technology was persistent. Indeed, this persistent problem that went unsolved until West km product was introduced in approximately 2003 to resolve the shortcomings of the state of the art and provide the advantages discussed

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<sup>9</sup> Exh. 6 of My First Declaration; Greenberg Traurig interview.

herein. Indeed, Claims 9, 10, 12, 13, 22 and 29 and each of the claims depending therefrom address and solve, for the first time, these long felt needs.

***COMMERCIAL SUCCESS SUPPORTS NON-OBTAINABILITY***

14. West km has also enjoyed significant commercial success because of the tremendous customer demand (based on the long-felt need), and rapid and wide spread acceptance due to the features as recited in the pending claims. I believe this to be the case in the present patent application. Claims 9, 10, 12, 13, 22 and 29 encapsulate features of the West km product that have been the basis for customer demand, as illustrated by customers in their own words in the Exhibits to My First Declaration. In particular, for example, people want a knowledge management system that does broad searching of work-product and non-work-product databases with a single query (see Exh. 1 at page 3 “valuable documents [e.g., external Web site content] are easily accessible using West km’s ... searching capabilities”; Exh. 2 at page 1 “research on internal documents”; Exh. 3 at page 3 “integration with the firm’s intranet and features”; Exh. 4 at 4 “bring the power of Westlaw\* behind [the firm] firewall” such searching being “with enhanced content”)

15. Our commercial success with West km is not the result of extensive advertising. In fact, West km as recited in the claims of the invention is not the type of product that can be sold by advertising hyperbole. Rather, the purchasers of West km are tough, sophisticated buyers who are lawyers, managers of information technology and/or knowledgeable in legal library science. These buyers purchase West km based on detailed review of the product features (typically our representative provides a detailed on site demonstration using actual test data provided by the potential customer) and one-on-one



contact with our sales staff. Promotion of West km has been largely through this personal contact and word of mouth. Thus, I know why West km is purchased and the advantages provided by the claimed features are what allows us to make these significant sales.

16. West km is also comparable priced to competing legal search services, and therefore the commercial success of West km is not due to aggressive pricing or discounts.

17. In summary regarding commercial success, the combination of these features is what enables law firms, corporate legal departments, and government agencies to leverage the content millions of internal documents (that cost hundreds of millions of dollars to produce) and efficiently provide thorough and informative search results. The net result is being able to complete work in less time. This helps our clients to work more efficiently, making them more competitive. In short, West km adds value, which has created widespread adoption in the marketplace.

***THE PRIOR ART IS NOT RELATED TO OUR INVENTION***

18. In my opinion, the claims of the present application have been rejected as being obvious over what amount to patent search engines and general data processing techniques (e.g., Rivette, Barney and Houben). There is simply nothing in these patent search engines or any others that would lead one to develop a product such as West km. West km and patent search engines are in totally separate fields of endeavor that are unrelated. This is because documents of interest to law firms include not only judicial opinions but internal work product documents such as memos and briefs, which are fundamentally different from patent documents. Work product documents and judicial opinions include citations to legal authority, which are most typically citations to

published legal decisions and statutes. If such underlying authority in the citations is overturned, then the respective proposition may not be proper. Lawyers need to know such information and have traditionally performed an act called shepardizing to determine it. Patent documents have no such interrelationship. Hence, the patent searching references are not relevant to the field of storing, searching and displaying legal document as set forth in this patent application.

***THE PRIOR ART DOES NOT TEACH OUR INVENTION***

19. Regarding the results of patent search engines, patents sometimes cite other patents. The cited documents in patents are not considered to be internal legal work product. They are merely publicly available documents. Hence, there is no single search that yields results of combined internal law-firm content and content of the online legal research service such as recited in Claim 10.

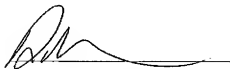
20. Still further, users do not do searches for patents to determine whether they cite current legal authority. Put another way, patent search engines are concerned with different goals, objectives and content than West km. Using a patent search engine reference to reject the instant application is without a sound logical basis, particularly since these references have no teaching of an engine that sorts through and creates results from firm internal work product documents and content of an online legal research database. There is nothing in the art that I am aware of to include such different multiple types of content.

21. In contrast to patent search engines like those of Rivette, Barney and Houben, West km, as embodied for example in Claim 9, determines whether the content of a brief or memorandum is still useful or not to a practitioner, by having each citation

associated with an indicator of current reliability of its corresponding document as a legal authority. Claim 29 recites a similar limitation. By having the indicator of current reliability, a user can know if, for example, the legal authority cited therein has been overturned or modified. This is an invaluable feature of West km, and it is claimed in the pending claims of this patent application and is lauded by users of the product. (E.g., Exh. 6). In short, none of the patent search engine materials disclose or suggest an the indicator of current reliability as recited in Claims 9 and 29. If a referred to patent document has been invalidated in a court of law, the user has to conduct additional research to determine that fact.

22. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of any patent issuing from this patent application.

July 29, 2011

A handwritten signature in black ink, appearing to read 'Donald Hayden', with a long horizontal flourish extending to the right.

Donald Hayden